

REMARKS

This application includes pending claims 80-115, all of which stand rejected under 35 U.S.C. 103(a) as being unpatentable over Peckover (U.S. Patent 5,119,101), in view of Walker (U.S. Patent 5,794,207). Claims 1-79 have been previously canceled.

Independent claims 80, 92 and 104 recite a method, system or machine-readable medium for facilitating transactions over a network that includes receiving, from a data subject, an offer to buy products or services from an authorized data recipient. These claims are allowable over the prior art for at least the following reasons.

In this rejection in the Office Action, the Examiner includes a list of features that are supposedly disclosed by Peckover, but does not explain how these features relate to the features in the claims. For example, taking the first element of claim 80, “receiving, from a data subject, an offer associated with a data recipient and a message including a network communication device software identifier”, the Office Action never explains where this claimed feature is disclosed in the cited references. Instead, the Office Action makes various assertions about users and parties initiating and accepting offers, connecting to the network, parties being selected as targets, etc. However, the Office Action never even asserts that Peckover (or the other prior art) discloses “receiving, from a data subject, an offer associated with a data recipient and a message including a network communication device software identifier.” The offer as claimed must be: (1) received from a data subject (a first party) and (2) associated with a data recipient (a second party). The Office Action never points to such an offer, and ignores this argument previously presented by Applicants.

The Examiner indicates that Peckover does disclose “offers and messages may be received by a consumer” and “offers may be associated with a merchant.” (office action, p. 11). In support, there are four portions of Peckover cited, none of which disclose receiving, from a data subject, and offer associated with a data recipient as required by the claims.

The first citation indicates column 23, lines 20-30, of Peckover; this section discloses merely that there are objects within Peckover's market that handle advertisements. Specifically, the reference indicates that one manager handles advertisements for sales and another “accepts *advertisements of offers to buy* that are submitted by users' Personal Agents 12.” (Peckover, col. 23, ll. 27-29, italics added). The only party mentioned as involved in the advertisement is the party submitting the ad (the “placer”). The ad is thus received from the placer (a first party) but the ad is not disclosed as being associated with a particular data recipient (a second party).

The second portion of Peckover cited is column 26, lines 40-67, which simply indicates the structure of an advertisement; it does not disclose or suggest any actions in response to the ad, nor does it disclose or suggest the involvement of any parties other than the party placing the ad. The only party mentioned is the “placer [, who] is the user (person or organization) who is selling or buying.” (Peckover, col. 26, ll. 42-43). As discussed above, this does not disclose receiving an offer from a data subject, the offer being associated with a particular data recipient.

The third supporting citation offered is Figure 31 and its related text in conjunction with column 33, line 50, through column 34, line 24. This section, like the others cited, merely explains the process of placing an advertisement. Never is it disclosed that another party is associated with the advertisement. Throughout the cited portion, Peckover uses “offer to buy” interchangeably with “advertisement of an offer to buy.” In particular, Peckover teaches “[a]n advertisement may be an offer to sell or an offer to buy” (col. 33, ll. 52-53) and “[t]he provider selects the type of ad: a sell advertisement (an offer to sell) or a buy advertisement (an offer to buy)” (col. 34, ll. 13-15). These are all the references within the cited portion to an offer to buy; there is no response mentioned, nor any party other than the placer that is associated with the offer. Because none of the cited references disclose or suggest this feature, it is not obvious in light of the prior art.

The fourth supporting citation offered is col. 23, line 63-col. 24, line 19. This section seems to have nothing at all to do with offers, but instead discusses search functions.

Second, the prior art does not disclose or suggest “determining whether the data subject is registered” as required by the independent claims of the Application. Specifically, Peckover

teaches away from using such a system. For example, Peckover claims “[a] computer network agent system for providing communication between *an anonymous potential customer...*” (Peckover, col. 39, ll. 18-20) (emphasis added). Though Peckover does collect user information at one point, that information is kept in the Owner Manager. “An Owner Manager function **52** maintains data about the human “owner” of the agent...This data is *always protected by an Individual Firewall **58**; it is never revealed to other agents, and is used only by components of Personal Agent **12**...*” (Peckover, col. 18, l. 62, through col. 19, l. 2) (italics added). This is not registration with any network or any other system; no person other than the user can verify any of the information held by the Personal Agent, and no one even verify that such information exists. The data are intended to be anonymous and thus teach away from registration. “A Personal Search Engine **26** maintains indexes over preference data and demographic data of all Personal Agents...However, *private data about the user (name, address, etc.) is not maintained* in the Personal Agent Search Engine **26**.” (Peckover, col. 16, ll. 49-54) (italics added). Thus, Peckover teaches away from determining whether a data subject is registered.

Third, the references do not disclose or suggest “sending a purchase query to [a] data subject,” nor does the reference disclose or suggest “sending purchase transaction information to [a] data recipient.” The Office Action does not even assert that this feature is disclosed in any cited reference. Peckover does not disclose or suggest any method of purchase; the reference is solely concerned with the information underlying a market purchase. As Peckover discloses, “[t]he principal object of the present invention is to provide a system that facilitates the *gather and exchange of market information in support of electronic commerce.*” (Peckover, col. 10, ll. 61-63) (emphasis added). Peckover repeatedly emphasizes the informational nature of that invention:

- “The present invention relates to the *gathering and analysis* of market transaction data, where such transactions are contemplated or completed by electronic means...” (Peckover, col. 1, ll. 13-15) (emphasis added)
- “The present invention contemplates a system for enabling the *collection of market information...*” (Peckover, col. 14, ll. 15-16) (emphasis added)

- “Consumers use Decision Agents to *gather the information* that helps consumers make ... decisions. Providers use Demand Agents to *assist with market analysis* ... and to *target consumers.*” (Peckover, col. 14, ll. 45-51) (emphasis added)
- “[I]t is only necessary that products be advertised within the system.” (Peckover, col. 27, ll. 56-57)

Peckover mentions that “[i]t is anticipated that, in the future, the system will further comprise actual purchase transactions.” This does not disclose or suggest sending a purchase query to the data subject, nor does it disclose or suggest sending purchase transaction data to the data recipient, both of which are required for the independent claims.

Walker does not disclose or suggest “sending a purchase query to the data subject” either. Instead Walker teaches away from such functionality. In fact, sending a purchase query to a buyer (or data subject) would destroy the intended function of Walker. Walker indicates that the entire point of that invention is to create legally binding offers to buy, thus the buyer (or data subject) would be unable to accept or reject a response from a seller (or data recipient). This is explicitly disclosed in Walker several times:

- “Potential sellers then have the option to accept a purchase offer and thus bind the corresponding buyer to a contract” (Walker, Abstract)
- “A key element ... is the seller’s ability to bind a buyer to a legal contract under the terms of the buyer’s posted offer.” (Walker, col. 4, ll. 13-16).
- “[A]llowing a seller to bind the buyer on the front end of the transaction will alleviate some seller concerns regarding enforcement because the seller has the opportunity to bind the buyer to a legally enforceable contract.” (Walker, col. 4, ll. 23-27).
- “[the] invention provides a method and apparatus for prospective buyers ... to communicate a binding purchase offer globally ... and for sellers to bind a buyer to a contract ...” (Walker, col. 8, ll. 28-32).

Thus, Walker does not disclose or suggest sending a purchase *query* to a buyer (or data subject). Even if Walker did disclose or suggest this feature, there would be no motivation to combine the

references. Walker involves placing buyer information directly in a central registry; once a buyer has placed an advertisement in Walker, any seller may accept the terms and immediately bind the buyer to a contract and charge the buyer's accounts for the required amount (or less, in case of an escrow transaction). Furthermore, buyer information is stored throughout the central database in Walker. Buyer's name and credit card information may be stored in at least four separate places: the buyer database **255** (Walker, col. 13, ll. 1-5), the purchase confirmation database **275** (Walker, col. 13, ll. 41-44), the payment database **285** (Walker, col. 13, ll. 50-53), and the buyer account **297** (Walker, col. 13, ll. 63-64). This would completely destroy the goal of anonymity and information protection in Peckover.

None of the three portions, or any other portions, of the references disclose or suggest the features of the independent claims. For at least these reasons, claims 80, 92 and 104 are allowable, as are all dependent claims.

Specifically in support of claims 81, 93 and 105, Peckover does not disclose or suggest determining whether a network communications device software identifier matches an entry in a database in order to determine whether a data subject is registered. Peckover discusses only four databases, none of which are disclosed as performing this feature.

The additional features of dependent claims 82, 94 and 106 are not disclosed or suggested in the prior art. The cited references do not disclose or suggest an offer containing a data recipient identifier, an item price, a data recipient digital signature, a final price indicator, and a transaction number. As discussed above, Peckover includes no teachings related to actual purchase transactions, thus it would be irrelevant for Peckover to disclose an offer that contained a transaction number. Further, Peckover is silent as to any digital signing. Finally, there is no mention of price negotiations or modifications in either Peckover or Walker, thus a final price indicator would have been meaningless within the references. Particularly in Walker, where an offer could be legally binding in its terms, it would destroy the function of the invention to allow the price to change after the offer was accepted. As all transaction processing is handled

automatically and immediately by the central controller, changes in price would be impossible within Walker. (Walker, col. 19, l. 13, though col. 20, l. 30).

Regarding claims 85, 97 and 109, the prior art does not disclose or suggest obtaining a new price from a data recipient based on a shipping address or preferred shipping method. As explained above, Peckover teaches against the disclosure of information regarding one user to a different user. To disclose a shipping address or preferred shipping method, that information would pass outside the bounds of the user's Personal Agent, which is expressly prohibited. In Walker, as well, this feature would destroy the purpose of that invention. Walker explicitly binds the users to a contract as soon as a seller accepts the buyer's offer. Though a buyer's ad could specify a shipping address and preferred method, thus allowing the seller to set a price specific to that information, this is not the same as modifying offers on the fly. Additionally, in Walker the person responsible for any shipping is made aware of all of these factors within the offer. Thus it would make no sense to include any changes in price based on shipping information. Therefore, the cited references do not disclose or suggest the features of claims 85, 97 and 109.

Finally, it is noted that the Office Action makes the generalized statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Peckover, Walker and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose the claimed limitations." Is the Examiner taking the position that it would have been obvious to combine these references in their entirety? There is no explanation of which portion or features of the applied references the Examiner feels it would have been obvious to combine. As set forth in MPEP 706.02(j), the Examiner should set forth in the Office Action the proposed modification of the applied references necessary to arrive at the claimed invention. It is submitted that such has not been done.

Because the prior art fails to teach the claimed limitations, a *prima facie* case of obviousness has not been established.

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The Office is authorized to charge any fees due under 37 C.F.R. §§ 1.16, 1.17 or 1.136 to deposit account 11-0600. In view of the remarks submitted above, the Applicants respectfully submit that the present case is in condition for allowance.

Should the Examiner have any questions concerning this matter, he is invited to contact Applicants' undersigned attorney at 202/220-4334.

Respectfully submitted,



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